



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|----------------------------|-------------------------|
| 10/796,604 | 03/08/2004 | Richard S. Bein | H-KN-01944(1) (1847-49) | 1765 |
| 55748 | 7590 | 01/17/2012 | EXAMINER | SAMALA, JAGADISHWAR RAO |
| Covidien | | | ART UNIT | PAPER NUMBER |
| Attn: IP Legal Department | | | | 1618 |
| 15 Hampshire Street, Bldg. 4A | | | | |
| Mansfield, MA 02048 | | | | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 01/17/2012 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|-----------------------------------------------------------------|---------------------------------------|------------------------------------|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/796,604 | Applicant(s) BEIN ET AL. |
| | Examiner JAGADISHWAR SAMALA | Art Unit 1618 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) They raise the issue of new matter (see NOTE below);
 - (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. Applicant's reply has overcome the following rejection(s): _____.
6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. Other: _____.

/Jake M. Vu/
Primary Examiner, Art Unit 1618

Continuation of 11. does NOT place the application in condition for allowance because: The critical elements required by the instant claims (ethylene vinyl alcohol copolymer; dimethylsulfoxide; and from about 45 to no more than 60 weight percent of tantalum contrast agent) and desired viscosity of 150 cSt or higher at 40°C are taught by the cited references. In instant case Whalen reference in combination with Patterson et al and Porter et al teaching provides desired composition.

Applicant argues that Whalen does not teach the use of a contrast agent in an amount from 45 to no more than 60 weight percent in the composition.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,208 USPQ 871 CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091,231 USPQ 375 (Fed. Cir. 1986). In this case, the Whalen et al. patent is relied upon to show that it is known in the art a composition comprising: a biocompatible polymer at a concentration of from about 2 to about 50 weight percent; and a biocompatible contrast agent at a concentration of from about 10 to about 40 weight percent; and a biocompatible solvent from about 10 to about 88 weight percent wherein the weight percent of the biocompatible polymer, contrast agent and biocompatible solvent is based on the total weight of the complete and composition and wherein the composition has a viscosity of at least about and more preferably at least about 200 cSt at 40°C (abstract and 0032-0036), while the Patterson et al ('864) and Porter et al ('302) patent's shows an equivalence of embolic composition comprising a biocompatible water-insoluble contrast agent from about 20 to about 55 weight percent ('864-0213 and '302-0069).

Applicant argues that both Porter and Patterson, which teach the need for employing rheology modifiers in their compositions to obtain a proper viscosity, teach away from the recited composition.

This argument is not persuasive since both Porter and Patterson teaches a composition comprising biocompatible water-insoluble contrast agent from about 20 to about 55 weight percent. The inclusion of additional rheology modifier agents enhances the deliverability of the compositions and high viscosity is also achieved (0029) In doing so, the property of the composition disclosed by Porter and Patterson is not diversified from the instant invention where the viscosity is 150 cSt or higher at 40°C. Thus, the instantly claimed invention is *prima facie* obvious. Thus, examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is more where there is more teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Claims 25, 27-29 are rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims of 1-6 of US Patent No. 5,667,767 ('767) and claims 1-8 and 16-23 of US Patent No. 5,695,480 ('480) are maintained for reasons of record in the previous office action filed on 04/09/2010 and applicants request for abeyance is acknowledged.